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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,902

01/06/2006

Stephen Berman

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MINEOLA, NY 11501

EXAMINER

HUYNH, KHOA D

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

05/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

<b>Office Action Summary</b>	Application No. 10/563,902	Applicant(s) BERMAN, STEPHEN	
	Examiner Khoa D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/6/06</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the clip that when pressed and held into place against the side of the writing instrument presses a release button as recited in claim 14, and the bladders can be pumped by...pressing and releasing the bladders as recited in claims 15 and 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

Claim 11 is objected to because of the following informalities: claim 11 recites limitations that are similar to claim 12. Accordingly, claim 12 should have been cancelled. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 calls for "a clip that when pressed and held into place against the side of the writing instrument presses a release button". Such recitations render the claim indefinite since it does not have detailed supports in the instant specification. Since the claim does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable.

Regarding claim 15, the phrase "can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Also, claim 15 calls for "the bladders can be pumped by...pressing and releasing the bladders". Such recitations render the claim indefinite since it does not have detailed supports in the instant specification. Since the claim does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable.

Regarding claim 16, the phrase "can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Also, claim 15 calls for "the bladders can be pumped by...pressing and releasing the

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bladders". Such recitations render the claim indefinite since it does not have detailed supports in the instant specification. Since the claim does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 8-13, 15 and 16, as presently and best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Hohlbein et al. (2005/0186014).

Regarding claim 8, the Hohlbein et al. reference discloses an apparatus (Figs. 8 & 9). The apparatus includes a barrel (constituted by the interior space) having bladders (at 40) built into the barrel, and a pumping mechanism (Fig. 9) for pumping air into the bladders, wherein the pumping mechanism includes an airway passage (at 82) and a one-way valve (at 84) for air to enter from the pumping mechanism into the bladders. In addition, the apparatus is capable of being used as a writing instrument for writing on a surface such as a sand surface.

Regarding claim 9, as schematically shown in Fig. 9, the pumping mechanism appears to be an integrated clicker (at 74) and a pump handle (constitute by the portion which housed elements 82, 86, 78).

Regarding claim 10, as schematically shown in Fig. 9, the pumping mechanism includes a pump handle (constitute by the portion which housed elements 82, 86, 78) that is separate from the clicker (at 74).

Regarding claims 11 and 12, as schematically shown in the cross-section of Fig. 9, the bladders are formed of a plastic or rubber material.

Regarding claim 13, a release mechanism (86) is located on the side of the instrument for release excess air.

Regarding claims 15 and 16, the bladder is manually pumped by the user pressing and releasing the pump mechanism to inflate the bladders.

4. Claims 8, 13 and 14, as presently and best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lindsey (2005/0043110).

Regarding claim 8, the Lindsey reference discloses an apparatus (Figs. 1 & 2). The apparatus includes a barrel (constitute by the interior space formed between elements 10 & 12) having bladders (at 10) build into the barrel, and a pumping mechanism (about 20) for pumping air into the bladders, wherein the pumping mechanism includes an airway passage (at 24) and a one-way valve (air pump 24 is inherently included a one-way valve) for air to enter from the pumping mechanism into the bladders. In addition, the apparatus is capable of

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being used as a writing instrument for writing on a surface such as a sand surface.

Regarding claims 13 and 14, a release mechanism (at 22) is located on the side for releasing excess air, wherein the release mechanism includes a clip that when pressing and held into place against the side to release excess air from the bladders.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoa D. Huynh  
Primary Examiner  
Art Unit 3751

HK  
04/29/2007